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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,140	11/18/2003	Dean L. Engelhardt	Enz-52(C)(D3)	7276
28171	7590	10/17/2006	EXAMINER	
ENZO BIOCHEM, INC. 527 MADISON AVENUE (9TH FLOOR) NEW YORK, NY 10022			LU, FRANK WEI MIN	
			ART UNIT	PAPER NUMBER

1634

DATE MAILED: 10/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/717,140	Applicant(s) ENGELHARDT ET AL.	
	Examiner Frank W. Lu	Art Unit 1634	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91-123 is/are pending in the application.
- 4a) Of the above claim(s) 106 and 109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91-105, 107, 108 and 110-123 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/18/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of species (1) (claim 105) in the reply filed on July 12, 2006 is acknowledged. The traversal is on the ground(s) that "[I]t is Applicants' position that it would not be a significant burden to search the recited sequences".

The above argument has been fully considered and has not been found persuasive toward the withdrawal of the species election nor persuasive toward the relaxation of same such that species (1) to (3) will be examined together. First, since these species are directed to different ways for linking said RNA polymerase (iii) and said RNA polymerase (iii), their search are not coextensive and different searches are required for these species. Second, applicant has no evidence to show why different searches are not required for these species. Therefore, the requirement is still deemed proper and is therefore made FINAL. Claims 91-105, 107, 108, and 110-123 will be examined.

Information Disclosure Statement

2. The examiner notes that applicant does not provide legible copies for JP 146299 and Promega catalog, page 150, Figure 4G in the information disclosure statement filed on December 10, 2003, these references have not been considered in Form PTO-1449 filed on December 10, 2003 (see attached the Form PTO-1449).

Oath/Declaration

3. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because the inventor, Dean L. Engelhardt does not sign a date in the oath/declaration.

Drawings

4. The some parts in Figures 8-15 (gel pictures) are hardly observed. Applicant is required to submit new Figures 8-15 in response to this office action.

Specification

5. The abstract of the disclosure is objected to because the abstract in this instant applicant has more than 150 words. Correction is required. See MPEP § 608.01(b).

6. The disclosure is objected to because of the following informalities: (1) since U.S. case 10/260,031 now is abandoned, applicant is required to update this information in the first sentence of the specification; (2) U.S. case 09/260,031 in the first sentence of the specification is not applicant's case and is a wrong case, please delete; (3) Figures 5, 6, and 18 contain nucleotide sequences having more than 10 nucleotides. However, there are no SEQ ID Nos in Figures 5, 6, and 18 and there are no SEQ ID Nos for these nucleotide sequences in the BRIEF DESCRIPTION OF THE DRAWINGS of the specification related to Figures 5, 6, and 18; (4) U.S. case 07/968,706 in page 14 of the specification now is US Patent No. 5,288,609, applicant is

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required to update this information; (5) U.S case 07/499,938 in page 18 of the specification now is abandoned, applicant is required to update this information; (6) U.S case 07/633,730 in page 35 of the specification now is abandoned, applicant is required to update this information; and (7) there are a nucleotide sequence having more than 10 nucleotides in pages 61 of the specification, there is no SEQ ID No for this nucleotide sequence in pages 61 of the specification.

Appropriate correction is required.

Claim Objections

7. Claims 91, 110, and 119 are objected to because of the following informality: “present” in the preamble of the claims should be “presents”.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. New Matter

Claim 122 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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Newly added claim 122 requires that said primer comprises tRNA. However, the specification fails to define or provide any disclosure to support such claim recitation.

Furthermore, in applicant's remarks filed on November 18, 2003, applicant does not indicate which part in the specification supports such claim recitation.

MPEP 2163.06 notes "If NEW MATTER IS ADDED TO THE CLAIMS, THE EXAMINER SHOULD REJECT THE CLAIMS UNDER 35 U.S.C. 112, FIRST PARAGRAPH - WRITTEN DESCRIPTION REQUIREMENT. *IN RE RASMUSSEN*, 650 F.2D 1212, 211 USPQ 323 (CCPA 1981)." MPEP 2163.02 teaches that "Whenever the issue arises, the fundamental factual inquiry is whether a claim defines an invention that is clearly conveyed to those skilled in the art at the time the application was filed...If a claim is amended to include subject matter, limitations, or terminology not present in the application as filed, involving a departure from, addition to, or deletion from the disclosure of the application as filed, the examiner should conclude that the claimed subject matter is not described in that application." MPEP 2163.06 further notes "WHEN AN AMENDMENT IS FILED IN REPLY TO AN OBJECTION OR REJECTION BASED ON 35 U.S.C. 112, FIRST PARAGRAPH, A STUDY OF THE ENTIRE APPLICATION IS OFTEN NECESSARY TO DETERMINE WHETHER OR NOT "NEW MATTER" IS INVOLVED. *APPLICANT SHOULD THEREFORE SPECIFICALLY POINT OUT THE SUPPORT FOR ANY AMENDMENTS MADE TO THE DISCLOSURE*" (emphasis added).

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 91-105, 107, 108, 110-121, and 123 are rejected under 35 U.S.C. 102(b) as being anticipated by Engelhardt *et al.*, (US 2001/0000077 A1, published on March 29, 2001).

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Since US cases 08/182, 621 and 09/302,817 were abandoned on July 10, 1997 and December 4, 2001 respectively and US cases 08/182, 621 and 09/302,817 are not co-pending with case10/260,031 and this instant case, priority date of this instant case is filing date of case10/260,031, which is June 6, 2003.

Regarding claims 91 and 92, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one segment of said specific nucleic acid comprising a sequence coding for a protein; and (iii) an RNA polymerase as recited in claim 91 wherein said at least one promoter (i) comprises a cognate promoter for said RNA polymerase (iii) as recited in claim 92 (see page 17, the conjugate in claims 73-78).

Regarding claims 93-95, Engelhardt *et al.*, teach that said protein-nucleic acid construct comprises a double-stranded nucleic acid as recited in claim 93, said protein-nucleic acid construct comprises a single-stranded nucleic acid as recited in claim 94, said protein-nucleic acid construct comprises a partially single-stranded nucleic acid as recited in claim 95 (see page 17, claims 60 and 64).

Regarding claims 96-98, Engelhardt *et al.*, teach that said sequence coding for a protein in said segment (ii) comprises a sequence for said RNA polymerase (iii) as recited in claim 96, said sequence coding for a protein in said segment (ii) comprises a protein other than said RNA polymerase (iii) as recited in claim 97, said sequence coding for a protein in said segment (ii) comprises a sequence for said RNA polymerase and a sequence for a protein other than said RNA polymerase as recited in claim 98 (see Figure 3C and page 9, [0094]).

Regarding claims 99 and 100, Engelhardt *et al.*, teach that said sequence coding for a protein in said segment (ii) comprises a sequence for a second RNA polymerase that is different from said RNA polymerase (iii) as recited in claim 99 and a second promoter for said second RNA polymerase as recited in claim 100 (see page 9, 102 and page 17, claims 81-90).

Regarding claim 101, Engelhardt *et al.*, teach that said RNA polymerase (iii) comprises T7, T3, SP6 or a combination thereof (see page 17, claim 62).

Regarding claim 102, Engelhardt *et al.*, teach further comprising a sequence for a protein wherein said protein is transcribed from said second promoter (see Figure 3C and page 9, [0094]).

Regarding claim 103, Engelhardt *et al.*, teach that said protein comprises DNA polymerase or reverse transcriptase (see page 17, claims 73-80).

Regarding claims 104, 105, 107, and 108, Engelhardt *et al.*, teach that said protein-nucleic acid construct comprises at least one chemically modified nucleotide or nucleotide analog as recited in claim 104, said RNA polymerase (iii) is linked to said protein-nucleic acid construct by means of a covalent linkage as recited in claim 105, said RNA polymerase (iii) is linked to said nucleic acid construct by means of a nucleic acid binding protein as recited in claim 107, said nucleic acid binding protein comprises a repressor protein bound to an enzyme as recited in claim 108 (see page 17, claims 60, 65, 66, 68, and 69).

Regarding claim 110, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one segment of said specific nucleic acid

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comprising a template for transcription; and (iii) an RNA polymerase (see page 9, [0102], page 17, claims 74-80, and Figure 3C).

Regarding claims 111-116, Engelhardt *et al.*, teach that said specific nucleic acid being produced comprises sense RNA, antisense RNA transcripts or a combination of both as recited in claim 111 and said sense RNA codes for a protein as recited in claim 112 (claims page 17, claims 87 and 89), said protein coding sense RNA codes for said RNA polymerase (iii) as recited in claim 113, said protein coding sense RNA codes for a protein other than said RNA polymerase (iii) as recited in claim 114, said protein coding sense RNA codes for said RNA polymerase (iii) and a protein other than said RNA polymerase (iii) as recited in claim 115, and said protein coding sense RNA comprises a sequence for a second RNA polymerase that is different from said RNA polymerase (iii) as recited in claim 116 (see page 9, [0094], [0102] and [0103] and Figure 3C).

Regarding claims 117 and 118, Engelhardt *et al.*, teach further comprising a second promoter for said second RNA polymerase as recited in claim 117 and further comprising a sequence for a protein, wherein said protein is transcribed from said second promoter (see page 9, [102], page 17, claims 81-90, and Figure 3C).

Regarding claims 119-121, and 123, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one single-stranded segment comprising a sequence complementary to a primer present in said cell; and (iii) a polymerase as recited in claim 119, said polymerase comprises an RNA polymerase or a DNA polymerase as recited in claim 120, said polymerase comprises DNA polymerase or reverse transcriptase as

recited in claim 121, and said sequence codes for a protein as recited in claim 123 (see page 17, claims 60-80).

Therefore, Engelhardt *et al.*, teach all limitations recited in claims 91-105, 107, 108, 110-121, and 123.

12. Claims 91-105, 107, 108, 110-121, and 123 are rejected under 35 U.S.C. 102(e) as being anticipated by Engelhardt *et al.*, (US 6,986,985 B1, filed on March 3, 1998).

Since US cases 08/182, 621 and 09/302,817 were abandoned on July 10, 1997 and December 4, 2001 respectively and US cases 08/182, 621 and 09/302,817 are not co-pending with case 10/260,031 and this instant case, priority date of this instant case is filing date of case 10/260,031, which is June 6, 2003.

Regarding claims 91 and 92, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one segment of said specific nucleic acid comprising a sequence coding for a protein; and (iii) an RNA polymerase as recited in claim 91 wherein said at least one promoter (i) comprises a cognate promoter for said RNA polymerase (iii) as recited in claim 92 (see column 26, the conjugate in claims 1-9).

Regarding claims 93-95, Engelhardt *et al.*, teach that said protein-nucleic acid construct comprises a double-stranded nucleic acid as recited in claim 93, said protein-nucleic acid construct comprises a single-stranded nucleic acid as recited in claim 94, said protein-nucleic acid construct comprises a partially single-stranded nucleic acid as recited in claim 95 (see column 6, second paragraph and Figure 1F).

Regarding claims 96-98, Engelhardt *et al.*, teach that said sequence coding for a protein in said segment (ii) comprises a sequence for said RNA polymerase (iii) as recited in claim 96, said sequence coding for a protein in said segment (ii) comprises a protein other than said RNA polymerase (iii) as recited in claim 97, said sequence coding for a protein in said segment (ii) comprises a sequence for said RNA polymerase and a sequence for a protein other than said RNA polymerase as recited in claim 98 (see column 26, claims 3-5).

Regarding claims 99 and 100, Engelhardt *et al.*, teach that said sequence coding for a protein in said segment (ii) comprises a sequence for a second RNA polymerase that is different from said RNA polymerase (iii) as recited in claim 99 and a second promoter for said second RNA polymerase as recited in claim 100 (column 26, claims 5 and 6).

Regarding claim 101, Engelhardt *et al.*, teach that said RNA polymerase (iii) comprises T7, T3, SP6 or a combination thereof (see column 15, second paragraph).

Regarding claim 102, Engelhardt *et al.*, teach further comprising a sequence for a protein wherein said protein is transcribed from said second promoter (see column 26, claim 7).

Regarding claim 103, Engelhardt *et al.*, teach that said protein comprises DNA polymerase or reverse transcriptase (see column 15, second paragraph).

Regarding claims 104, 105, 107, and 108, Engelhardt *et al.*, teach that said protein-nucleic acid construct comprises at least one chemically modified nucleotide or nucleotide analog as recited in claim 104, said RNA polymerase (iii) is linked to said protein-nucleic acid construct by means of a covalent linkage as recited in claim 105, said RNA polymerase (iii) is linked to said nucleic acid construct by means of a nucleic acid binding protein as recited in

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claim 107, said nucleic acid binding protein comprises a repressor protein bound to an enzyme as recited in claim 108 (see column 15, first and second paragraphs).

Regarding claim 110, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one segment of said specific nucleic acid comprising a template for transcription; and (iii) an RNA polymerase (see claim 9 in columns 26 and 27).

Regarding claims 111-116, Engelhardt *et al.*, teach that said specific nucleic acid being produced comprises sense RNA, antisense RNA transcripts or a combination of both as recited in claim 111 and said sense RNA codes for a protein as recited in claim 112 (claims page 17, claims 87 and 89), said protein coding sense RNA codes for said RNA polymerase (iii) as recited in claim 113, said protein coding sense RNA codes for a protein other than said RNA polymerase (iii) as recited in claim 114, said protein coding sense RNA codes for said RNA polymerase (iii) and a protein other than said RNA polymerase (iii) as recited in claim 115, and said protein coding sense RNA comprises a sequence for a second RNA polymerase that is different from said RNA polymerase (iii) as recited in claim 116 (see columns 27 and 28, claims 10-15).

Regarding claims 117 and 118, Engelhardt *et al.*, teach further comprising a second promoter for said second RNA polymerase as recited in claim 117 and further comprising a sequence for a protein, wherein said protein is transcribed from said second promoter (see column 28, claims 16 and 17).

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Regarding claims 119 and 123, Engelhardt *et al.*, teach a conjugate, which when presents in a cell, produces a specific nucleic acid, said conjugate comprising a protein-nucleic acid construct that comprises: (i) at least one promoter; (ii) at least one single-stranded segment comprising a sequence complementary to a primer present in said cell; and (iii) a polymerase as recited in claim 119 wherein said sequence codes for a protein as recited in claim 123 (see column 26, claim 1 and column 6, second paragraph).

Regarding claims 120 and 121, Engelhardt *et al.*, teach that said polymerase comprises an RNA polymerase or a DNA polymerase as recited in claim 120 and said polymerase comprises DNA polymerase or reverse transcriptase as recited in claim 121, and (column 15, second and third paragraphs).

Therefore, Engelhardt *et al.*, teach all limitations recited in claims 91-105, 107, 108, 110-121, and 123.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 122 is rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt *et al.*, (1998 or 2001) as applied to claims 91-105, 107, 108, 110-121, and 123 above, and further in view of Toothman (US Patent No. 6,001,572, filed on July 24, 1997 and published on December 14, 1999).

The teachings of Engelhardt *et al.*, (1998 or 2001) have been summarized previously, *supra*.

Engelhardt *et al.*, (1998 or 2001) do not disclose that said primer comprises tRNA as recited in claim 122.

Toothman teaches that said primer comprises tRNA (see column 4, last paragraph).

Therefore, it would have been *prima facie* obvious to one having ordinary skill in the art at the time the invention was made to have made a conjugate recited in claim 122 wherein said primer comprises tRNA in view of the prior art of Engelhardt *et al.*, (1998 or 2001) and Toothman. One having ordinary skill in the art would have been motivated to do so because Toothman suggests that a primer comprising tRNA would take advantage of the extreme conservation of the tRNA genes (see column 4, last paragraph). One having ordinary skill in the art at the time the invention was made would have been a reasonable expectation of success to make a conjugate recited in claim 122 wherein said primer comprises tRNA.

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

16. Claims 91-105, 107, 108, 110-121, and 123 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-90 of copending Application No. 09/727,349. Although the conflicting claims are not identical, they are not patentably distinct from each other because an obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but examined claims in this instant application are not patentably distinct from the reference claims because the examined claims are either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 91-105, 107, 108, 110-121, and

123 in this instant application are not identical to claims 1-90 of copending Application No. 09/727,349, claims 1-90 of copending Application No. 09/727,349 are directed to the same subject matter and fall entirely within the scope of claims 91-105, 107, 108, 110-121, and 123 in this instant application. In other words, claims 91-105, 107, 108, 110-121, and 123 in this instant application are anticipated by claims 1-90 of copending Application No. 09/727,349.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

17. Claims 91-105, 107, 108, 110-121, and 123 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,986,985 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because an obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but examined claims in this instant application are not patentably distinct from the reference claims because the examined claims are either anticipated by, or would have been obvious over, the reference claims. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). Although claims 91-105, 107, 108, 110-121, and 123 in this instant application are not identical to claims 1-18 of U.S. Patent No. 6,986,985 B1, claims 1-18 of U.S. Patent No. 6,986,985 B1 are directed to the same subject matter and fall entirely within the scope of claims 91-105, 107, 108, 110-121, and 123 in this instant application. In other words, claims 91-105, 107, 108, 110-121,

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and 123 in this instant application are anticipated by claims 1-18 of U.S. Patent No. 6,986,985

B1.

Conclusion

18. No claim is allowed.

19. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746.

The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571)272-0735.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

October 2, 2006



**FRANK LU
PRIMARY EXAMINER**